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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/16/2001

Mary Connors

1081-01

7886

7590

03/06/2006

IP Department  
Schnader Harrison Segal & Lewis  
36th Floor  
1600 Market Street  
Philadelphia, PA 19103

EXAMINER

SMITH, JEFFREY A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/998,570	CONNORS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey A. Smith	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

The response filed December 27, 2005 has been entered and considered.

Claims 1-13 are pending.

Claims 1, 4, 6-8, 10, 11, and 13 are currently amended.

An action on the merits of claims 1-13 follows.

### ***Drawings***

The drawings were received on December 22, 2005. These drawings are approved.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 4-7, 12 and 13:

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These claims read-on a program, per se, since the program and its associated instructions are not embodied in any tangible medium. MPEP 2106.

Regarding claims 8-11:

These claims recite "devices" which are disclosed in the specification as being "software" or programs. Such "software" or programs are not embodied in any tangible medium. MPEP 2106.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 8, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Aycock et al.

Aycock et al. discloses a method for the identification and evaluation of software products and software product vendors (col. 1, lines 10-21). Note that the method described by Aycock et al. relates primarily to an evaluation of maturity

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requirements from a quality perspective. However, Aycock teaches that the "arrangement may also be used in evaluating a supplier's capability to meet technical specifications for products and services" (col. 15, lines 24-28).

Regarding claim 1: The method comprises, *inter alia*, identifying software features that are required and the functions that it must perform (col. 5, lines 47-49); creating a specification comprising said features and functions (col. 10, lines 25-28); rating each feature and function (col. 6, lines 17-19); ranking each feature and function (col. 2, lines 42-46); assigning weights to categories of features and/or functions (col. 6, lines 37-54); ranking software products according to how closely they match the features and functions the created specification (col. 10, lines 25-28); generating a table of qualifying products and vendors (col. 7, lines 13-45); generating a short list of vendors and products using the weighted table of qualifying products and vendors (col. 7, lines 46-65); creating a table comparing selected products with the requirements and comparing the specification with the qualifying products (col. 15, lines 13-23).

Claims 4, 8, 12 and 13 are parallel in format and are similarly anticipated.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5-7, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aycock et al. (U.S. Patent No. 5,765,138).

Although Aycock discloses generating a custom request for proposal for vendors on the short list (col. 7, line 66-18), Aycock does not disclose sending such custom request via email.

However, it would have been obvious to one of ordinary skill in the art to have sent such custom requests already generated by Aycock via email as such transmission medium was well-known at the time of the invention and would have offered merely an alternative mode of communication which would not have otherwise affected the operation of the Aycock method.

***Response to Arguments***

Applicant's argument filed December 27, 2005 directed to the traversal of the rejections of claims 1-3 under 35 USC 101 for failing to recite a non-trivial application of technology in the body of these claims is persuasive.

Applicant has not traversed or otherwise overcome the rejections of claims 4-13 under 35 USC 101 on different grounds at page 7 of the Office action mailed June 24, 2005. Those rejections are repeated above.

Applicant's arguments filed December 27, 2005 directed to the traversal of the rejections of claims 1, 4, 8, 12, and 13 under 35 USC 102 have been fully considered but they are not persuasive.

Applicant argues that the Aycock et al. method is not for creating requests for proposal (RFP).

The Examiner notes that Aycock discloses that the system "provides a more efficient generation of requests for proposals (RFP/RFQs)" (col. 2, lines 42-46). The system of Aycock et al. is not limited to "evaluating responses to requests for proposal that have already been created and distributed" as alleged by Applicant.

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Applicant argues that other features of the claims including "ranking each feature and function", "ranking software products according to how closely they match the features and functions in the created specification" and "generating a short list of vendors and products using the weighted table of qualifying products and vendors" are not disclosed by Aycock.

The Examiner disagrees. As stated in Aycock:

"[a]lthough the disclosed embodiments relate primarily to an evaluation of maturity requirements from a quality perspective, it will be appreciated that the above arrangement may also be used in evaluating a supplier's capability to meet technical specifications for products and services" (col. 15, lines 24-28).

That being said, Aycock et al. additionally states at column 2, line 57-column 3, line 23:

"The method and apparatus for evaluating supplier capabilities may be used by a purchasing agent of an entity (public or private) interested in purchasing products or software services. According to the present invention, vendor requirements are selected for a vendor qualification, and the vendor requirements are assigned a relative weight on the basis of project objectives. The requirements are provided to a supplier, for example in the form of software which may be downloaded from the evaluator's business system to the supplier's sales department. After receiving supplier responses to the requirements, the supplier responses are assigned a scaled score on the basis of corresponding desired vendor responses. The scaled score of the supplier responses are correlated with the relative weight of the requirements, and a supplier maturity level is calculated representing an objective evaluation of the supplier responses. The supplier maturity level refers to the supplier's sophistication and capabilities in establishing and



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maintaining quality standards in the design, production, distribution, serviceability, and reliability of the supplier's product or service. Additional iterations of vendor requirements and supplier responses may be provided to obtain more detailed evaluations of a supplier. After the supplier maturity level has been calculated, a supplier site evaluation is conducted based on the supplier maturity level and the vendor requirements in order to generate an on-site evaluation report. The on-site evaluation report is compared with the supplier maturity level to provide a combined supplier evaluation between the supplier responses and the supplier site evaluation. The supplier is then selected as a vendor in accordance with the combined supplied evaluation."

When taken in view of the entire prior art document, it is clear that Aycock et al. discloses a method for the evaluation of software products and software product vendors as recited in the claims. Applicant should not limit their review of the prior art to passages cited by the Examiner, but rather should view the passages in the context of the entire prior art document.

Applicant has not independently traversed or otherwise overcome the rejections of claims 2, 3, 5-7, and 9-11 under 35 USC 103. Those rejections are repeated above.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

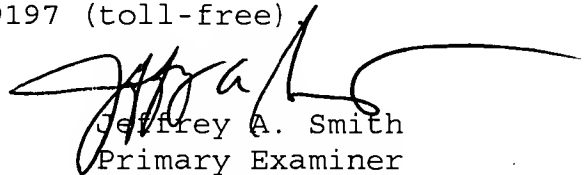
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

  
Jeffrey A. Smith  
Primary Examiner  
Art Unit 3625

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